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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,525	10/21/2005	Nicholas P. De Luca	D-30335-01	6004

7590 02/06/2009
Daniel B Ruble
Sealed Air Corporation
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EXAMINER

MOORE, WALTER A

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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02/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/532,525	Applicant(s) DE LUCA, NICHOLAS P.	
	Examiner WALTER MOORE	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,9,10 and 15-57 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-6,9,10 and 15-57 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-6 and 9-10, drawn to a packaging cushion insert.

Group II, claims 15-20, drawn to a method of making a packaging cushion insert.

Group III, claims 21-39 and 48-55, drawn to a machine for making a packaging cushion insert.

Group IV, claim(s) 40-47 and 56-57 drawn to a method of using a machine to make a packaging cushion insert.

2. The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same special technical feature for the following reasons:

- a. The common technical feature between groups I and II is a stack of sheets comprised of a top sheet, a bottom sheet, and a plurality of interior sheets, wherein the top sheet is attached to at least one of the interior sheets and the bottom sheet is attached to at least one interior sheet. In groups I and II, the sheets are air-cellular material.

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- b. The common technical feature between groups I and III is a stack of sheets, wherein the sheets are attached together.
 - c. The common technical feature between groups I and IV is a stack of sheets comprised of a top sheet, a bottom sheet, and a plurality of interior sheets, wherein the top sheet is attached to at least one of the interior sheets and the bottom sheet is attached to at least one interior sheet.
 - d. The common technical feature between groups II and III is a stack of sheets, wherein the sheets are attached together.
 - e. The common technical feature between groups III and IV is a conveyor for conveying sheets under a cutter head, a cutter for cutting sheets, and a means of stacking sheets, compressing, and adhering the sheets together.
3. Therefore, the common technical feature shared between all of the groups is a stack of sheets, wherein the sheets are attached together. In order to be considered a "special technical feature," the common technical feature shared between each group must provide a contribution over the prior art.
4. Evidence of lack of unity between the groups is found in Marzano, USPN 6,139,188, because Marzano discloses a stack of sheets, which are attached together. Marzano discloses a packaging cushion insert useful for cushioning a packaged object, the insert comprising: a top sheet (Fig. 4, Ref. No. 27, Col. 4, ln. 59-61); a bottom sheet (Fig. 4, Ref. No. 27, Col. 4, ln. 61); and a plurality of interior sheets between the top and bottom sheets (Fig. 4, Ref. No. 28, Col. 4, ln. 59-62), wherein the top sheet, the bottom sheet, and the plurality of interior sheets are in stacked arrangement (Fig. 4, Ref. No. 27

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and 28); each sheet is attached to the other sheets (*welded together*, Col. 4, ln. 55); and the sheets are air-cellular cushioning material (*bubble wrap*, Col. 4., ln. 1). Since Marzano teaches the common feature shared between all of the groups, there is no special technical feature. So, there is a lack of unity between the inventions.

5. A telephone call was not made to request an oral election to the above restriction requirement because the restriction requirement is too complex.

6. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

7. The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

8. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

9. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process

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claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WALTER MOORE whose telephone number is (571) 270-7372. The examiner can normally be reached on Monday-Thursday 9:00-4:00.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/WM/

Walter Moore, AU 1794

2/3/2009

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1794